

REMARKS/ARGUMENTS

Claims 1-12, 14-36 and 38-60 were rejected.

The Office Action has been carefully considered. Claims 1-12, 14-36 and 38-60 are pending. Claims 13 and 37 are canceled. The Office Action rejected Claims 1-12, 14-36 and 38-60 in the following manner.

1. Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,185,306 to Mages et al. (hereinafter “*Mages*”) in view of U.S. Patent No. 6,510,553 to Hazra (hereinafter “*Hazra*”).
2. Claims 2-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*, and further in view of U.S. Patent No. 6,373,831 to Secord et al. (hereinafter “*Secord*”).
3. Claims 9-12, 14-36, and 38-60 were rejected under the same criteria as above.

Claim 38 is currently amended to correct an errant dependency. Claims 1, 15, 26, 32, 39, 51, and 53 are amended to correct erroneous antecedent references. Specifically, the corrected claims now refer to “the plurality of second file portions” (plural). Claims 8, 19, 38, 44, and 60 are currently amended to clarify the intended scope of the claims.

Specifically, a “key” used for decryption is now explicitly referred to as “a decryption key.” Applicants believe that these amendments merely clarify the existing subject matter of the claims.

35 U.S.C. § 103 Rejections

To establish a *prima facie* case of obviousness, Office personnel have the burden to meet three basic criteria. First, Office personnel must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, not based on applicant’s disclosure. Second, Office personnel must show that the teachings in the prior art have a reasonable expectation of success. Finally, Office personnel must show that the combined prior art references teach or suggest every element of the claim. *See* MPEP § 2142.

Mages in view of Hazra does not teach or suggest every element of Claim 1.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*. However, Applicants respectfully submit that neither *Mages* nor *Hazra*, alone or in combination, teaches or suggests every element of Claim 1. Claim 1 reads as follows:

A method of creating a media file for playing in an electronic device, comprising:

receiving a first file portion of the media file with the electronic device from a first computing device via a first communication channel as a result of commands initiated from a media client of the electronic device, wherein the first file portion **lacks at least one non-header portion** and is unusable as a media file;

receiving a plurality of second file portions of the media file with the electronic device from a second computing device via a second communication channel as a result of commands initiated from the media client, wherein the plurality of second file portions are unusable as a media file and the media client initiates commands resulting in said receiving of the plurality of second file portions **without reference to the content of the first file portion to identify the second computing device**; and

creating with the media client the media file in the electronic device from the first file portion and at least one of the plurality of second file portions.

***Mages* in view of *Hazra* does not teach or suggest that the first file portion lacks at least one non-header portion and is unusable as a media file.**

By current amendment, Claim 1 specifies that “the first file portion **lacks at least one non-header portion** and is unusable as a media file.” Support for this amendment is found in at least Fig. 2B, which shows that that portions removed from the media file “include the header 221 and other portions of the file selected according to a predetermined formula.” ¶ [54].

By contrast, *Mages* teaches merely that content or a “HyperCD” may be “crippled” by “achieved by removing critical information such as the video-audio header, whereupon such video/ audio data is rendered unreadable by the end-user's computer.” Col. 6 lines 39-43. *Hazra* teaches merely that that an entire media file “may be authored as multiple independent streams.” Col. 8 line 54-Col. 9 line 15.

Applicants respectfully submit that neither *Mages* nor *Hazra*, alone or in combination, teaches or suggests that “the first file portion **lacks at least one non-header portion** and is unusable as a media file,” as claimed in Claim 1.

***Mages* in view of *Hazra* does not teach or suggest that the plurality of second file portions are retrieved without referring to the content of the first portion of the media file.**

Mages discloses a system in which an address or URL is stored along with a first portion of a media file so that the second portion of the media file (e.g., its header information) may be retrieved from that address or URL. For example, *Mages* discloses that a first (crippled) portion of a media file may be contained on a CD-ROM and further that “the CD-ROM contains a code representing the URL web page of the host computer where the necessary de-crippling key is located.” Col. 6 lines 57-60. Thus, the Office Action correctly notes that *Mages* does not teach or suggest “receiving a plurality of second file portions of the media file... without reference to the content of the first file portion to identify the second computing device,” as claimed in Claim 1. To paraphrase, *Mages* does not disclose that the second portions of media files must be retrieved without referring to the content of the first portion of the media file.

In addition, the Office Action correctly notes that *Mages* does not disclose “receiving a **plurality** of second file portions,” as claimed in Claim 1. *Mages* consistently and repeatedly refers to crippled media that may be accessed upon the receipt of only one single “uncrippling or triggering key.” *E.g. Mages* Col. 6 lines 5, 16, 20, 59; Col. 7 line 28.

However, the Office Action incorrectly asserts that *Hazra* remedies these defects in *Mages*. *Hazra* discloses merely a plurality of completely independent multimedia streams: any number of signal sources may be active and available for serving multimedia data streams to multimedia access and display devices at any time. Each signal source stores or has access to at least a portion of a digital multimedia content represented as a sequence of audio and video data signals called streams.

Col. 4 lines 24-29. *Hazra* does not, however, teach or suggest a “receiving a **plurality of second file portions of the media file**,” at least one of which is necessary to reassemble a usable media file and each of which is retrieved without referring to the content of a first portion, as claimed in Claim 1. In asserting to the contrary, the Office Action cites to

Hazra's Col. 8 line 54-Col. 9 line 15, which discloses that an entire media file “may be authored as multiple independent streams” according to a process developed by the assignee of this application. According to the disclosed process, “the author may choose to take the same video content and encode it with different encoding parameters (e.g., data rate, frame rate, video size), storing all the resultant streams in the same file. The client system may switch between the different available streams under conditions of changing bandwidth....” Col. 9 lines 3-10.

This disclosure *Hazra* is antithetical to the invention claimed in Claim 1. According to the plain language of Claim 1,

- each file portion represents a portion (i.e., part, fragment, segment, piece) of a single whole media file,
- each file portion is unusable on its own as a media file, and
- the single whole media file can be reassembled from the first and at least one of the second portions.

Thus, Claim 1 recites that a plurality of independently unusable second file portions may be received without reference to the content of the first file portion. Bearing in mind these characteristics of Claim 1’s “file portions,” it is apparent that *Hazra* does not teach or even suggest any element of Claim 1, let alone “receiving of the plurality of second file **portions** without reference to the content of the first file **portion**.”

On the contrary, as related to Claim 1, *Hazra* discloses merely that a device may receive multiple independent streams, streams that are “independent in the sense that each stream may be decoded without any information from the other streams.” Col. 8 line 65-Col. 9 line 2. In other words, *Hazra* discloses receiving a second independent stream without reference to the content of a first independent stream. Thus, *Hazra*, alone or in combination with *Mages* fails to, teach or suggest anything regarding the receipt of file portions as claimed in Claim 1.

As described above, Claim 1 recites limitations that are patentably distinct from what is taught or suggested by *Mages* in view of *Hazra*. Accordingly, Applicants respectfully submit that Claim 1 is not obvious considering *Mages* in view of *Hazra*. Independent Claims 9, 15, 26, 32, 39, 51, and 53 are also allowable through similar reasoning.

One of ordinary skill in the art would have had no motivation to combine *Mages* with *Hazra* in order to arrive at the invention claimed in Claim 1.

To establish a *prima facie* case of obviousness, Office personnel have the burden to show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. *See* MPEP § 2142.

More recently published guidelines alter this burden only slightly. Specifically, the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007) (hereinafter “*KSR Examination Guidelines*”), state as follows:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Id. at 57,528-29 (quoting *KSR International Co. v. Teleflex Inc.*, 550 U.S. at –, 82 USPQ2d at 1396). The new examination guidelines go on to state that to make a § 103(a) rejection such as in the present case, Office personnel must articulate “[s]ome teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.” *KSR Examination Guidelines* at 57,534 (emphasis added). In *KSR*, the Supreme Court explained that when conducting a § 103 obviousness analysis, it is generally “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S.Ct. at 1741. (emphasis added).

According to the Office Action at 3, “[i]t would have been obvious to one of ordinary skill in the art to combine the teachings of *Mages* and *Hazra* motivated by the desire for a faster transmission, thus avoiding ‘choppy’ playing of media.” This motivation is defective because Claim 1 is not directed towards avoiding choppy playback. Therefore, one who was motivated to avoid choppy playback would have arrived at an invention other than that claimed in Claim 1.

For example, if one were motivated to avoid choppy playback, one might adopt the process disclosed in *Hazra* wherein “the author may choose to take the same video content and encode it with different encoding parameters (e.g., data rate, frame rate, video size), storing all the resultant streams in the same file. The client system may switch between the different available streams under conditions of changing bandwidth....” Col. 9 lines 3-10. However, if one of ordinary skill did combine that process with the teachings of *Mages*, he or she would not arrive at the invention claimed in Claim 1 because Claim 1 is not directed towards switching between streams as bandwidth changes.

One of ordinary skill in the art would have had no motivation to combine *Mages* with *Hazra* because *Hazra* teaches away from the invention claimed in Claim 1.

In addition, one of ordinary skill seeking to solve the problems addressed by the invention claimed in Claim 1 would find no motivation to combine *Mages* with *Hazra* because *Hazra* teaches away from the invention. *See* MPEP § 2145, paragraph X.D.1. (citing *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be **discouraged** from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. ... [I]n general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is **unlikely to be productive of the result sought by the applicant**.

In re Gurley, 27 F.3d at 553 (emphasis added).

A reference that teaches away from a given combination may negate a motivation to modify the prior art to meet the claimed invention. *See, e.g., KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007) (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious).

One of ordinary skill seeking to arrive at the invention claimed in Claim 1 would find no motivation to combine *Mages* with *Hazra* because *Hazra* teaches away from the solutions implemented by the invention claimed in Claim 1. According to the application, the claimed inventions are generally directed towards “streaming media to portable computing devices without requiring maintenance of a wireless connection to the source of the streaming media throughout playback” in order to “reduc[e] overall power consumption in [a] wireless device.” *See* Abstract; ¶¶ [5-7]. (Although Claim 1 does not recite limitations related to a

“wireless connection,” the stated rationale of saving power applies with equal force to Claim 1’s “second communication channel.”) Thus, one of ordinary skill would have been motivated to seek solutions that do not require continuous connections and that tend to prolong battery life.

By contrast, *Hazra* contemplates that a connection to the streaming media source must be maintained while the media is playing. See, e.g., Col. 8 line 54-Col. 9 line 15. Thus, one of ordinary skill in the art would have been dissuaded from combining *Hazra* with *Mages* because *Hazra*’s teachings would have required a constant battery-draining connection, thereby thwarting his or her efforts to reduce overall power consumption.

Accordingly, one of ordinary skill in the art would not have been motivated to combine the cited references in order to arrive at the claimed invention. For this additional reason, Applicants respectfully assert that the Office Action has failed to state a *prima facie* case that Claim 1 (and through similar reasoning, Claims 9, 15, 26, 32, 39, 51, and 53) is obvious considering *Mages* in view of *Hazra*.

Claims 2-8 are allowable by dependency and because the Office Action has failed to state a prima facie case of obviousness.

Claims 2-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*, and further in view of *Secord*. However, Claims 2-8 are allowable at least by dependency because *Secord* does not, by way of disclosure or suggestion, remedy the deficiencies in *Mages* and *Hazra* that are discussed above. On the contrary, *Secord* describes merely a Code Division Multiple Access transmission system, such as is commonly used with cell phones.

Applicants therefore respectfully submit that Claims 2-8 are also allowable because an ordinarily skilled practitioner would have had no motivation whatsoever to modify the teachings of *Mages* and *Hazra* with those of *Secord*. Asserting to the contrary, the Office Action states that such a one would have been motivated “because employing portable computing devices are conventional functional equivalents of the claim limitations and it would be obvious to disconnect the receiver once reception is complete since wireless charges are based on per minute rates.” The Office Action cites no authority for its assertion about wireless charges. Thus, the asserted motivation to combine the cited references relies

on a mere conclusory statement, and according to the U.S. Supreme Court, “rejections on obviousness cannot be sustained by mere conclusory statements.” *KSR*, 550 U.S. at –, 82 USPQ2d at 1396. Thus, the Office Action has failed to state a *prima facie* case that Claims 2-8 are obvious.

The Office Action did not (and cannot) take official notice of the asserted fact that “wireless charges are based on per minute rates.” Official notice would be clearly improper in this case because there are many forms of wireless access that are not charged per minute. Per minute charges may be common (though not ubiquitous) in the CDMA world of *Secord*, but many forms of wireless access (e.g., Bluetooth and Wifi, *see* ¶ [94]) do not typically have per minute charges. Moreover, neither the cited references nor the application are directed towards minimizing per minute charges. Thus, the asserted motivation is not only an improper conclusory statement, but it is also at best only tangentially related to the subject matter of Claims 2-8.

Moreover, Applicants respectfully submit that there can be no motivation to combine *Mages* and *Hazra* with *Secord* because the *Secord* resides in an unrelated field. Applicants further respectfully submit that any motivation to combine them can be found only by using the present claims as blueprints to assemble otherwise unrelated elements using hindsight analysis, an analysis that is expressly forbidden:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention “as a whole.” Inventions typically are new combinations of existing principles or features. The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention.

Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004) (internal citations omitted); *see also, e.g., Texas Instruments Inc. v. U.S. Intern. Trade Com'n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993) (holding that it is impermissible to “piece the invention together using the patented invention as a template” when the “references in combination do not suggest the

invention as a whole”); *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”).

Applicants respectfully submit that the only motivation to combine *Secord* with *Mages* and *Hazra* is derived from the fact that the inventions claimed in Claims 2-8 suggest in hindsight that elements of *Secord* could be used with a device that implements a conceptually similar scheme to that disclosed in *Mages* and *Hazra*. Accordingly, the Office Action erred in asserting that an ordinarily skilled practitioner would have had any motivation to combine *Secord* with *Mages* and *Hazra*.

Claims 2-8 are allowable for additional reasons.

There are also additional reasons why Claims 2-8 are not obvious considering *Mages*, *Hazra*, and *Secord*. For example, the Office Action has not asserted that the prior art of record teaches or suggests “using the media client to make the memory in which a least a portion of the media file is stored available for re-use once at least a portion of the media file has been played,” as claimed in Claim 4. Applicants are unable to discern where, if at all, *Mages*, *Hazra*, and *Secord* teach or suggest this element. Thus, the Office Action has failed to state a *prima facie* case that Claim 4 is obvious.

For another example, *Mages* and *Hazra* do not teach or suggest the elements in Claim 7, which recites,

wherein creating the media file by the media client comprises:

examining by the media client **sequencing information** in one of the plurality of second file portions that describes where elements of the one of the plurality of second file portions should be placed within the first file portion to create the media file.

The Office Action offers no analysis at all in relation to sequencing information, nor do *Mages*, *Hazra*, or *Secord*, alone or in combination, teach or suggest sequencing information or use of sequencing information as claimed. The elements of this dependent claim do not appear to have been addressed at all by the examiner.

For yet another example, *Mages*, *Hazra*, and *Secord* do not teach or suggest the elements in Claim 8, which recites

wherein the first file portion is encrypted, and the method further comprising:
the media client obtaining at least one **decryption key from one of the plurality of second file portions**; and

decrypting the first file portion using the **decryption key obtained from the one of the plurality of second file portions.**

The Office Action asserts that *Mages* discloses that “uncrippling is based on employing a key.” However, there are two problems with this assertion. First, *Mages*’s “uncrippling keys” are not analogous to (and thus do not render obvious) Claim 8’s “decryption key.” Second, *Mages* does not teach or suggest that a decryption key may be “obtained from the one of the plurality of second file portions,” as claimed in Claim 8.

Mages discloses that an “uncrippling key” may be downloaded. However, an “uncrippling key” cannot be used to decrypt a first file portion as claimed in Claim 8 because *Mages* uses the term “crippled” to refer to processes other than encryption. For example, “[t]he crippling of the CD-ROM is achieved by removing critical information such as the video-audio header, whereupon such video/audio data is rendered unreadable by the end-user's computer.” Col 6 lines 38-42.

It is noted that it is possible to “cripple” the video/audio data on the CD-ROM by other means other than deleting the header thereof. For example, the file could be made a hidden file, with the trigger data from the host computer being a command to remove the hidden status. Alternatively, the video/audio file could have a changed extension, with the trigger data from the host computer being a command to change the extension. Moreover, the crippling of the video/audio file may be achieved by the use of ZIP file, with the trigger data from the host computer being a command to UNZIP the data.

Col. 8 lines 21-31 (emphasis added).

In addition, *Mages*’ uncrippling key is not used to decrypt a first file portion as claimed. On the contrary, when *Mages* speaks of “decrypting” in relation to an uncrippling key (or “trigger”), *Mages* is referring to decrypting the encrypted uncrippling key, which is then “combined” with unencrypted data to allow playback.

The encoding of the critical information such as “Header” trigger is achieved utilizing any conventional encoding program, such as, for example, RSA by Data Security (block 36). This encoding will create a trigger of a few bytes comprising all of the necessary information to trigger the CD-ROM, and to invoke the video and/or audio data.

Col. 7 lines 34-37 (wherein “RSA” is an algorithm for public-key cryptography that is well known in the art). According to *Mages*, it is the uncrippling key that is encrypted, not the file portion as claimed:

The end-user's computer has a specially-dedicated software program for catching the [uncrippling] key, decrypting the [uncrippling] key 5 from the

server and data from the CD-ROM 3, combining the [uncripling] key and data and playing it back.

Col. 7 lines 54-57.

Thus, an uncripling key as disclosed in *Mages* does not teach or suggest anything related to a decryption key as claimed in Claim 8.

Mages does disclose a “decryption key,” but *Mages*’ “decryption key” is not analogous to (and thus does not render obvious) Claim 8’s “decryption key.” On the contrary, *Mages*’ “decryption key” is used to decode the encoded uncripling key, but in all cases, *Mages* discloses that the decryption key is not obtained from a second file portion, as claimed in Claim 8. *See, e.g., Mages* Abstract (“[t]he requesting computer decrypts the video and/or graphic data and video player via a previously supplied decryption key”); Col. 3 lines 51-52 (“[i]t is the primary objective of the present invention to separate keys and data”); Col. 4 lines 48-51 (“encrypted video files and video player are downloaded to a requesting computer [already] having the software decryption keys”); Col. 9 lines 20-22 (“[e]ach user who is to be able to access the data... will [already] have a corresponding decryption key... for decrypting the data.”); Col. 10 lines 3-5 (“The encrypted player, such as JPEG, is decrypted, like the video data, using the decryption key (block 152) provided by the provider of the Web site”). Thus, *Mages* does not teach or suggest “obtaining at least one decryption key from one of the plurality of second file portions,” as claimed in Claim 8. Neither *Secord* nor *Hazra* remedies this defect.

Thus, for these additional reasons, Applicants respectfully submit that the Office Action has failed to state a *prima facie* case that Claim 8 is obvious.

Claims 9-12, 14-36, and 38-60 are allowable by similar reasoning.

Applicants respectfully assert that all remaining claims are patentably distinguishable from the cited documents on at least the same and/or a similar basis as Claims 1-8. Therefore, it is respectfully requested that the Examiner withdraw these rejection and allow the pending claims to proceed to issuance.

CONCLUSION

For at least the reasons above, Assignee respectfully submits that claims 1-12, 14-36, and 38-60 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Applicants do not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this Application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,
AXIOS LAW GROUP

Date: April 25, 2008

by: /Adam L.K. Philipp/
Adam L.K. Philipp
Reg. No.: 42,071
Phone: 206-217-2200
E-mail: adam@axioslaw.com

AXIOS Law Group
1525 4th Avenue, Suite 800
Seattle, WA 98101
Telephone: 206-217-2200
Customer No.: 61857